

Remarks

An Elections/Restriction Office Action (paper No. 4) was mailed July 1, 2003 restricting claims to one of seventeen figures identified by the office as patentably distinct species A-Q. That is, the applicant is advised through issuance of the office action (paper No. 4), that claims presented in the filed application along with any claims presented post filing of the application, which are readable on a selected one of the Office identified species presented by one of the figures 5-11, 13, 22-24, 30, 40, 42, 44, 47, or 49 are to be identified and associated with one of the Office identified species by the applicant, for purposes of examination on the merits.

This response provides amendments to the specification, to claims 1-13, and adds new claim 14, which depends from claim one. Amendments to the first paragraph of page 1, starting at line number 6 of the specification of the present application, have been made to clarify the Applicant's claim of priority to United States Patent Application Serial Number 09/059,146 filed April 13, 1998, issued October 16, 2001 as U.S. Patent 6,301,853 to affirm that the present application, application number 09/978,262, is a continuation in-part-application of United States Patent Application Serial Number 09/059,146 now U.S. Patent 6,301,853. The amendment to the first paragraph adds no new matter.

Amendments to the first full paragraph of page 18, starting at line number 5 of the specification of the present application (the portion of the application dealing with the description of FIG.9), have been made to provide an enhanced written description of the invention, and of the manner and process of making and using it in such effective terms as to better enable any person skilled in the art to make and use the same. The amendments to the first full paragraph of page 18 adds no new matter to the application, rather the amendments clarify the meaning of the term "... to draw the retaining groove 60C more tightly against tang member 72C." (page 18, line 9) by placing the term in context to afford a better understanding as to what the phrase "more tightly" within the term is in reference to.

The amendment to the portion of the application dealing with the description of FIG.9 starting at line number 5, page 18 of the specification of the present application further provides an enhanced understanding of the interrelationships between elements of the present invention shown by FIG. 9, in contrast to the elements shown by FIG. 6 of the present application.

Amendment to the middle paragraph of page 24, starting at line number 11 and continuing through line 16 of the same page, of the specification, of the present application (the portion of the application dealing with the description of FIG.30), has been made to correct a misidentification of the standing seam shown therein. The structure of the standing seam shown by FIG. 30, is the standing seam structure with the improved sidelap shear capacity shown by FIG. 9, i.e., standing seam 25C, rather than the standing seam 25B of FIG. 8, as called for in the description of the specification as filed. No new matter has been introduced with this amendment.

Amendments to each independent claim 1, 4, 8, and 11 have been made to place those claims in better condition for examination as combination claims each having a “means plus function” element. As will be recognized by the Examiner, 35 U.S.C. §112, paragraph six, provides:

“An element in a claim for a combination may be expressed as a means or steps for performing a specified function without the recital of structure, [or] material, or acts in support thereof, and shall be construed to cover the corresponding structure, [or] material, or acts described in the specification and equivalents thereof.” (*emphasis added*)

Because the elements “means for increasing the sidelap shear capacity of the assembly” (claim 1), “means for increasing the sidelap shear capacity of the standing seam assembly” (claim 4), “means for increasing the sidelap shear capacity of the adjacent roof panels” (claim 8), and “means for increasing the sidelap shear capacity of each standing seam assembly” (claim 11) each lack sufficient structure to support the function called for by each element (i.e., increasing the sidelap shear capacity), the Examiner must look to the specification to provide the support for the function called for by the claim element.

Claims 1, 4, 8, and 11 are written in accordance with 35 U.S.C. §112, sixth paragraph. The proper examination of this claim requires an identification of the corresponding structure, material, or acts in the specification and equivalents thereof, that carry out the functions recited in the claim. *In re Donaldson Company, Inc.*, 16 F.3d 1189 (Fed.Cir.1994)(*en banc*). Pursuant to 35 U.S.C. §112, ¶6, “structure disclosed in the specification is ‘corresponding structure’ only if the specification or

prosecution history clearly associates that structure to the function recited in the claim. This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing 112, paragraph 6.” *B. Braun Medical*, 43 USPQ2d at 1900. Additionally, in the second section of their opinion in *Ex parte Donner*, 53 USPQ2d 1699, March 26, 1999, the Board solidified the plain meaning of the phrase "means for" in a 'machine' claim to be the structure identified within the written portion of the specification that supports the function called for in the means claim.

In claims 1, 4, 8 and 11, the function called for by the element of each claim that is expressed as a means clause is; increasing the sidelap shear capacity of the [assembly, for claim 1], [standing seam assembly, for claim 4], [adjacent roof panels, for claim 8], and [increasing the sidelap shear capacity of each standing seam assembly]. The Applicant points out that the associated structure within the written portion of the specification that supports the function called for by the common portion of each means plus function claim element, i.e., “means for increasing the sidelap shear capacity”, for each of the claims 1, 4, 8 and 11 include: the species shown by FIG. 9 in conjunction with the discussion of FIG. 9 starting with the first full paragraph of page 18 at line 5 and continuing through the amended portion applicable to that portion of the specification; the species shown by FIG. 30 in conjunction with the discussion of FIG. 30 starting with the middle paragraph of page 24 at line 11 and continuing through line 16; the species shown by FIGS. 40 and 41 in conjunction with the discussion of FIGS. 40 and 41 starting with the last full paragraph of page 29 at line 14 and continuing through line 2 of page 30; the species shown by FIGS. 42 and 43 in conjunction with the discussion of FIGS. 42 and 43 starting with the first full paragraph of page 30 at line 3 and continuing through line 19 of page 30; the species shown by FIG. 44 in conjunction with the discussion of FIG. 44 starting with the last partial paragraph of page 30 at line 22 and continuing through line 5 of page 31; the species shown by FIGS. 47 and 48 in conjunction with the discussion of FIGS. 47 and 48 starting with the last full paragraph of page 35 at line 15 and continuing through line 23 of page 35; and the species shown by FIG. 49 in conjunction with the discussion of FIG. 49 starting with the first full paragraph of page 36 at line 1 and continuing through line 4 of page 36.

The applicant submits the amendment to claim 1, places claim 1 in a proper form as a generic claim. Each of the remaining independent claims 4, 8, 11, as well as the

dependent claims 2, 3, 5, 6, 7, 9, 10, 12, 13 and 14 have limitations beyond those expressed in claim 1, and are therefore species of generic claim 1.

Support for new dependent claim 14, is found in the portion of the specification dealing with the discussion of FIG. 9 starting with the first full paragraph of page 18 at line 5 and continuing through the amended portion applicable to that portion of the specification.

Support for each element of new independent claim 15 is as follows: for the first element “providing a first and second adjacent roof panel” is found on page 14, line 19 through page 15, line 1; support for the second element “interlocking a female sidelap portion of the adjacent first panel with a male portion of the second adjacent panel, the female sidelap having a first leg” is found on page 15, lines 1 through 6 and page 15, lines 16-17; support for the third element “pre-crimping a hook portion of the female sidelap portion” is found on page 24, line 23 through page 25, line 1; support for the fourth element “jointly forming a tang member of the male sidelap portion and a third leg of the female sidelap portion” is found on page 25, lines 1-4; support for the fifth element “crimping together the tang member of the male sidelap portion and the third leg of the female sidelap portion to form a standing seam” is found on page 27, lines 18-28; and support for the sixth and final element of independent claim 15, “downwardly forming the standing seam to create an acute angle with respect to the first leg of the female sidelap portion to form the standing seam assembly with sidelap shear capacity” is found in the portion of the specification dealing with the discussion of FIG. 9 starting with the first full paragraph of page 18 at line 5 and continuing through the amended portion applicable to that portion of the specification.

New independent claim 16 is a linking claim that incorporates two 35 U.S.C. §112, paragraph six, claim elements. That is, the use of the element “a standing seam assembly with a sidelap shear capacity provided by steps for forming a standing seam assembly with sidelap shear capacity” and the element “means for increasing the sidelap shear capacity of the standing seam assembly”.

Claim 16 properly links, the assembly in which adjacent panels are supported by underlying support structure in overlapping edge relationship to form the standing seam assembly with sidelap shear capacity resistant to sideslipping when subjected to applied forces, of claim 1, with the method for forming the standing seam assembly with sidelap shear capacity, of claim 15. (See MPEP 809.03)

To be fully responsive to the Office Action and to promote an expedited examination of the application, the issues raised in the Election/Restrictions of the Office Action (paper number 4) will now be briefly addressed.

Restriction Under 35 U.S.C. §121 to one of Office identified species A-Q :

The Examiner states:

“Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally found allowable. Currently, no claims are generic”

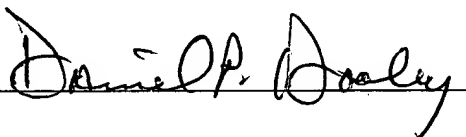
While the Applicant traverses the characterization that no claims are generic and the subsequent restriction of claims to one of seventeen Office identified species is improper, the Applicant provisionally elects with traverse, independent generic claim 1, dependent species claim 14, and linking claim 16, for examination on the merits.

The Applicant submits that; independent generic claim 1, is a proper independent generic claim constructed in accordance with the requirements of 35 U.S.C. § 112 paragraph 2, and drafted under the provisions of 35 U.S.C. § 112 paragraph 6; that the structure supporting the function called for by the claim element containing the “means plus function” clause of claim 1 has been identified within the specification by the Applicant; that the dependent claim 14, elected as a species for examination by the Applicant, is not a species that is an obvious variant of the other species identified by the Applicant; that each species identified by the applicant is a patentably distinct species of independent generic claim 1; that independent claims 4, 8, and 11 are non-obvious independent species of the independent generic claim 1; that independent claims 4, 8, and 11 are each drafted under the provisions of 35 U.S.C. § 112 paragraph 6, and must be examined accordingly; and that each dependent claim provides sufficient structure to remove each dependent claim from examination by the Examiner under the examination procedures of a “means plus function” drafted claim, drafted under the provisions of 35 U.S.C. § 112 paragraph 6.

This is intended to be a complete response to the Election/Restriction Office Action (Paper No. 4) mailed July 1, 2003. The Examiner is invited to contact the Attorneys listed below should any questions arise concerning this response.

Respectfully submitted,

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